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Reply Brief

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Berkel Van, Cornelis

Examiner: William L. Boddie

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REPLY BRIEF

In addition to the arguments presented in the Appeal Brief filed on March 11, 2010, and in response to the Examiner's Answer dated June 2, 2010, Appellant submits the following reply.

REMARKS

This Reply Brief is in response to the Examiner's Answer dated June 2, 2010. Reconsideration of this application is respectfully requested in view of the following remarks and all of the arguments in the appeal brief of March 11, 2010 and prior responses.

STATUS OF CLAIMS

- a) Claims 1 – 35 are pending. Claims 1, 24 and 33 are independent.
- b) Claims 1 – 35 stand rejected and are under appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1, 2, 4, 9 – 15, 20 – 22 and 24 – 31 are properly rejected under 35 U.S.C. §103(a) over Katabami (US 5,528,002) in view of Kable (US 4,695,680) and further in view of Makinwa (US 5,889,237).

B. Whether claims 33 – 35 are properly rejected under 35 U.S.C. §103(a) over Katabami in view of Stein et al. (US 5,365,461), hereinafter Stein, and further in view of Kable and Makinwa.

C. Whether claims 5 and 6 are properly rejected under 35 U.S.C. §103(a) over Katabami in view of Kable, and further in view of Makinwa and Yamanami et al. (US 4,902,858).

D. Whether claims 7, 8, 19 and 32 are properly rejected under 35 U.S.C. §103(a) over Katabami in view of Kable, and further in view of Makinwa and Ely et al. (US 6,667,740).

E. Whether claims 3, 16 and 17 are properly rejected under 35 U.S.C. §103(a) over Katabami in view of Kable, and further in view of Makinwa and Stein.

F. Whether claims 16 and 18 are properly rejected under 35 U.S.C. §103(a) over Katabami in view of Kable, and further in view of Makinwa and Teterwak (US 5,777,898).

G. Whether claim 23 is properly rejected under 35 U.S.C. §103(a) over Katabami in view of Kable, and further in view of Makinwa and Colgan et al. (US 6,204,897).

ARGUMENT IN RESPONSE TO THE EXAMINER'S ANSWER

The Examiner responds to Appellant's remarks starting on page 23 of the Examiner's answer. Appellant respectfully disagrees with the Examiner's comments for at least the following reasons.

For example, claim 1, in part, requires:

"a coil for coupling to ground along substantially the length of the user-holdable device."

In the Office Action, pages 5, the Examiner concedes that neither Katabami nor Kable disclose that the means for coupling to ground is a coil. The Examiner asserts that Makinwa teaches a coil for coupling to ground. As discussed previously in the Appeal Brief, Appellant maintains that the function of Makinwa's coil 202 is for transmitting the stylus signal and receiving an activation signal via capacitive coupling,

and that there is no indication in Makinwa that the coil 202 provides the function of coupling to ground.

In the Examiner's Answer, page 23, the Examiner agrees that the coil of Makinwa makes it possible to transmit and receive activation signals, but states that this is not the only function of the coil. The Examiner further asserts that if the coil were not present in the stylus of Makinwa, there would be no side 302, and thus the stylus would not be capacitively coupled to ground. The Examiner concludes that if the coil were absent, no coupling would occur and thus the coil is indeed for coupling to ground. Appellant respectfully disagrees with such assertion.

Using the Examiner's hypothetical situation and logic above, Appellant submits that just because the coil 202 requires an end to be connected to ground does not necessarily mean that the coil 202 itself performs the coupling to ground function. It is the side 302 that is coupled to ground (Makinwa, column 3, lines 41 – 43). If the coil were absent in the stylus of Makinwa, it could only be concluded that the coupling to ground was not needed. However, it does not follow that the side 302 cannot couple to ground in the absence of the coil. For example, Makinwa, Fig. 4, in another embodiment, shows that the detector 404 requires coupling to ground while the coil 202 apparently does not. This clearly shows that the need for coupling to ground is not unique to the coil only. Thus, the assertion that the coil 202 is for coupling to ground cannot stand. Therefore, Makinwa fails to teach or suggest the claimed feature: *a coil for coupling to ground*.

In addition, the claimed invention also requires that the coil for coupling is *along substantially the length of the user-holdable device*.

As discussed previously in the Appeal Brief, Appellant maintains that it is not obvious to combine Katabami, Kable and Makinwa to arrive at the claimed invention.

In the Examiner's Answer, page 24, the Examiner asserts that Kable provides additional structure underneath the conductive wall 76 in Fig. 1, for example. However, Appellant submits that Kable does not disclose that the additional structure underneath the conductive wall can serve as a wall or an outside structure of a stylus, which allows a user to hold. For example, element 76 in Fig. 1 is only a plastic spacer to hold the cartridge 24: it does not provide the structure of a wall or any structural equivalent. Therefore, Appellant maintains that the wall 12 in Kable provides a structure forming the body of stylus 10 (column 5, lines 39 – 45), and that a coil cannot suitably be used to replace the wall. Thus, if a coil were used, Kable's stylus 10 would lose an important structural feature – a wall forming the body of the stylus. A stylus without a wall forming the body is clearly not satisfactory for its intended purpose, i.e. a pen-like writing instrument, having a body for hand-holding.

The Examiner further asserts that it is seen as overwhelmingly simple for one of ordinary skill in the art to include a structural body within which to configure all of the elements of the device. Appellant respectfully disagrees and submits that such argument is a hindsight analysis. As discussed above, a key feature of Kable is to provide a conducting wall, forming the structure of the stylus. As such, there is no need to have any additional wall structure for the stylus. Had it not been for Appellant's

disclosure of “*a coil for coupling to ground along substantially the length of the user-holdable device*,” there would not be an analysis of needing an additional structural body in order to combine the teachings of Katabami, Kable and Makinwa. Therefore, it is not obvious for a skilled person to combine Katabami, Kable and Makinwa to arrive at the claimed invention.

CONCLUSION

As discussed above, the combination of references is woefully deficient in teaching each and every feature of Appellant’s claims, and Appellant respectfully submits that the rejection of claims 1 – 35 is in error, legally and factually, and must be reversed.

Respectfully submitted,

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